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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1952.

No. 709.

FRANK ADAM ELECTRIC COMPANY,
Petitioner,

vs.

FEDERAL ELECTRIC PRODUCTS CORPORATION,
Respondent.

PETITIONER'S REPLY BRIEF

Re Petition for Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit.

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We ask the Court to indulge us a few paragraphs of reply to the "Brief for Respondent in Opposition to Petition for Writ of Certiorari."

CONCERNING REASON I OF THE PETITION.

A plaintiff should be as much entitled to notice that he will be charged with laches at a hearing on a Motion for Summary Judgment as at a hearing on a Complaint and Answer. In drawing the distinction that a Motion for Summary Judgment is not a "pleading," Respondent's Brief

(pp. 7, 10) accents the importance of the "due process of law" question posed by the Petition. Rule 8 (c) of the Rules of Civil Procedure lays down a strict bar against surprise affirmative defenses, such as laches. Can it be that such a bar becomes an open door merely because the paper which tenders the issues to be heard happens to be styled "Motion"? Such would relegate the doctrine that "substance is paramount to form" into absurdity.

Twice in its brief (pp. 7, 11) Respondent asserts that while the laches was not asserted in its Motion, such was "argued in Respondent's Brief, filed and served at the same time as the Motion." The most charitable answer to this is that the writer of Respondent's Brief must have been looking at a text different from the one served and filed at the time the Motion was filed—for we have searched both our copy and the District Court's copy of that Brief in vain for any suggestion of laches, or that the reissue application was not "timely" filed.

The Jesionowski case has no pertinence here for two reasons. First, the statement of points (R. 60) did assign there that "the District Judge erred in concluding that the application for reissue was not timely."* Want of due process was but one facet of that "concise statement." Second, there is no contention here that any part of the record (as distinguished from Briefs) in the District Court was not in the Court of Appeals' record. In the Jesionowski case, the reverse was true. See 154 F. (2d) 704.

Only two of the cases cited at pages 11-12 of Respondent's brief pertain to reissues, and those two cases demonstrate that delay in filing a reissue application is of "small consequence" where the effect of the reissue is to narrow the original claim, i. e., where, as here, the original claim was too broad. This Court has never, insofar as we can

* While the District Judge termed it "not timely," and the Court of Appeals termed it "laches," we recognize no distinction in substance.

find, held a narrowing reissue invalid for delay in applying for it. On the contrary, in Thomson v. Wooster, 114 U. S. 104, 115, the Court says:

> "or, in the original patent the patentee may have claimed as his own invention more than he had a right to claim as new—a mistake which might be corrected **at any time.**" (Emphasis supplied.)

The situation is different with disclaimers because the statutory requirements are different. Unlike the reissue statute (R. S. 4916), both disclaimer statutes (R. S. 4917 and 4922) expressly deny their benefits to a patentee who "has unreasonably neglected or delayed to enter a disclaimer." There is no counterpart to this in the reissue statute. While this Court has held (Ensten et al. v. Simon Ascher & Co., 282 U. S. 445, 452-3) that "the same principle which forbids a patentee to assert a right to more than he has actually invented, compels him to disavow the right as soon as he discovers that it has been unjustly claimed," it certainly cannot be contended that Petitioner's patentee delayed such disavowal; because the Disclaimer (disavowing everything except that which is now covered by the reissue patent) was signed on the very same day as the Concession of Priority. Whether the form of the Disclaimer was good (as the Courts of Appeals of three Circuits had then held), or bad (as this Court decided in the Milcor case six months later), it was abundantly clear notice to the public that the patentee disavowed all that had been unjustly claimed. And that the disclaimer disavowed everything which the circumstances required, and hence was fair with the public, cannot be gainsaid because when the matter was submitted to the Patent Office Examiners, via the reissue application, the Examiners allowed claims of the precise same scope as had been delineated by the disclaimer.

CONCERNING REASON II OF THE PETITION.

The Marconi case (320 U. S. 1) cited by Respondent (Br. pp. 6, 12, 15, 16), and in the Court of Appeals' opinion, did not involve a reissue patent. The passages relied upon relate solely to disclaimers. Both remedies are available where a patentee has originally claimed more than he was entitled to, but they are otherwise quite different—both adjectively and substantively. This Court has never held disclaimer law to be applicable to reissue situations, and we think the Court of Appeals confused the two. If, as urged by Respondent, and as apparently done by the lower Court in this case, laches in applying for reissue is to be measured by the standards of the disclaimer law, this Court should say so to the end that there will be no further confusion about it.

Instead of acknowledging that the cases cited under Reason II (a) of the Petition support the proposition that claims carried over unaltered from an original patent into a reissue are unaffected, validity-wise, by the reissue proceedings, Respondent (Br. p. 14) compounds that proposition with the proposition discussed under Reason III of the Petition, and says that the cases do not support us. While we do not contend that any case previously considered by this Court involved a situation where the patentee sought to cure mistaken overclaiming, first by disclaimer, and then by reissue, we insist that since Gage v. Herring, 107 U. S. 640, and until the decision in this case, it was settled that claims carried over unaltered from an original patent are not invalid because of some defect in the reissue proceedings. Respondent has cited nothing to the contrary.

Of all the cases cited by Respondent against Reason II (b) of the Petition, one and only one concerned a **narrowing** reissue; and what Respondent says about that one is mistaken. Here is what they say (Br. p. 17):

> "In *Better Packages, Inc., v. Derby S* 43 F. Supp. 123, the delay in the case of reissue patent was only a few months after was told that his claims were too broad (684) not two and a half years as stated o the petition."

Here are the facts quoted from the Findings ported at 43 F. Supp. 124:

> ". . . on January 2, 1929, a memorand sion was entered finding claims 22, 24 and patent invalid. This decision was reduce cree on April 25, 1929, from which no taken."
>
> "Not until August 21, 1931, did plaintiff plication for the first reissue (No. 18,3 original patent, No. 1,638,815."

According to our arithmetic, from January August 21, 1931, is two years, eight months an days; from April 25, 1929, to August 21, 1931, is three months and twenty-six days. On either more than three times the "delay" between I concession of priority and application for reis than ten times the "delay" between the Milc and the reissue application.

Respondent's discussion emphasizes the nee Court to decide whether delay in applying for a reissue is still of "small consequence"; to be me different standards than those which apply wh issue broadens the original claim; or "a mist might be corrected at any time," as variously this Court a half century ago.

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CONCERNING REASON III OF THE PETITION.

Of course, the concession of priority, and the filing of the Disclaimer were "deliberate acts," albeit, the latter was induced by a mistaken forecast of what this Court would subsequently declare the law to be. But neither of those "deliberate acts" was what made the four claims of the original patent invalid—they had been invalid from the day the original patent was granted, without the patentees even knowing it. Those claims were invalid ab initio, because in the language of the reissue statute (R. S. 4916), the patentees had claimed as their own invention more than they "had a right to claim as new." Being already invalid, neither of the "deliberate acts" can be said to have made the claims invalid. Neither is it rational to say that an invalid disclaimer could so revalidate the patent that the original invalidity no longer existed.

The suggestion (Br. p. 18) that we did not "inform the Patent Office that the reissue application included the four claims as modified by the invalid disclaimer" belies the very passage of the reissue oath which is quoted at page 5 of Respondent's Brief, and completely ignores Rule 90* of the Rules of Practice in the United States Patent Office, then in force.

The rhetoric about the terrorization of the public for twelve years is not only devoid of factual basis, but wholly inconsistent with Petitioner's immediate public proclamation via the disclaimer of the restricted scope upon which it would stand, and has since stood. The reissue simply added the endorsement of the Patent Office to the propriety of the restriction which the disclaimer had imposed upon the claims.

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* 90. An original claim, if reproduced in the reissue specification, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications, excepting that division will not be required.

IN REPLY TO THE DISCUSSION UNDER "RESPONDENT'S POINTS"

(Br. pp. 19-21).

The first of these was raised by the Motion, but not decided by either the Court of Appeals or the District Court. The second and third of these were **not** raised by the Motion, but were decided by the District Court. The Court of Appeals did not pass upon either of them.

The first point would seem to be disposed of by the fact that Petitioner's reissue patent was granted by the Patent Office with full knowledge that the Jackson and Kingdon patent (R. 203) had already been granted, and thus the reissue patent is endowed with a presumption that all claims therein patentably distinguish from that which had been patented by others. Furthermore, it is worth noting that Jackson and Kingdon sought an interference on said claims 7 and 9, and the Patent Office refused it (R. 225) because the subject matter thereof "is not shown by applicant," i. e., Jackson and Kingdon.

As to the second and third points, it is important to note that the inadvertence, accident or mistake relied upon in the reissue application was not, as Respondent says (Br. p. 3), "constituted by the invalid disclaimer" to the exclusion of the original mistaken overclaiming.

Respondent omits to quote the following passage from the reissue oath (R. 35):

> ". . . that the patentees originally claimed as their invention, more than they had a right to claim as new, particularly in that:
>
> Claims 13, 14, 18 and 19 of said original patent, as originally granted, were too broad in that they embraced subject matter of which deponents were not the first inventors and more specifically that

> said claims were not limited to arrangements wherein the bar members were positioned both laterally and (fol. 16) transversely by the overlying and underlying portions of the base together with the side walls of the 'opening' or 'slot';
>
> and deponents further say that the errors, which render such patent so invalid in part, arose from inadvertence, accident or mistake and without any fraudulent or deceptive intention on their part;"

While the reissue oath proceeded to bring out the involvement of the unduly broad claims in the interference, and to recount the filing of the disclaimer and the subsequent decision of this Court in the Milcor case, it is abundantly clear that it was the error in making of claims 13, 14, 18 and 19 too broad in the first place which was at the root of all invalidity in the patent, and it has not been suggested that that error was other than an honest mistake. Respondent's argument seems to be based upon the curious premise that a disclaimer which, they say, was invalid for the purpose intended, was nonetheless valid enough to eradicate the original mistake in the patent to the point where that original mistake was no longer available as a statutory reason for reissue.

We respectfully submit that the several questions presented by the Petition are in such need of clarification by this Court that the interest of the entire patent-minded public would be served by the granting of the Writ.

Respectfully submitted,

JOHN H. SUTHERLAND,
Attorney for Petitioner.

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IN THE

Supreme Court of the United States

October Term, 1952

No. 324 Misc.

PHILIP FRANKFELD, GEORGE AGGITEUS MEYERS, LEROY HANS WOOD, REGINA FRANKFELD, DOROTHY ROSE BLUMBERG, and MAURICE LOUIS BRAVERMAN,

Petitioners,

vs.

UNITED STATES OF AMERICA,

Respondent.

Motion for Leave to File Brief Amici Curiae and Brief Annexed in Support of Petition for Rehearing.

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